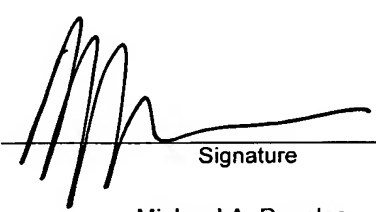




Doc Code: AP.PRE.REQ

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 10040010-1	
	Application Number 10/782,051-Conf. #5731	Filed February 19, 2004	
	First Named Inventor Rory L. Van Tuyt		
	Art Unit 2873	Examiner R. E. Hanig	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>40,381</u></p> <p> _____ Signature Michael A. Papalas _____ Typed or printed name (214) 855-8186 _____ Telephone number February 28, 2006 _____ Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			

<input type="checkbox"/> *Total of <u>1</u> forms are submitted.
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Pre-Appeal Brief Request for Review	
I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482725217US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.	
Dated: February 28, 2006	Signature: <u>Donna Forbit</u> (Donna Forbit)



Agilent Technologies, Inc.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, Colorado 80537-0599

Docket No.: 10040010-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Rory L. Van Tuyl

Application No.: 10/782,051

Confirmation No.: 5731

Filed: February 19, 2004

Art Unit: 2873

For: DEVICE FOR REMOTELY STIMULATING
AND MEASURING ELECTRONIC SIGNALS
THROUGH A FIBER OPTIC CABLE

Examiner: R. E. Hanig

APPELLANT'S ARGUMENTS
FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

The Appellant hereby requests that a panel of Examiners formally review the legal and factual basis of the rejections of record prior to the filing of an Appeal Brief. This Request is filed with a Notice of Appeal.

ISSUES

The sole current rejection against the claims is a 35 U.S.C. § 103(a) rejection asserting that the claims are obvious over US 5,898,517 (hereinafter, *Weis*). Appellant herein points out clear error in the rejection. Specifically, Appellant believes that there is a lack of motivation to modify *Weis* as suggested. While Appellant believes that various features of the claims are not taught by the cited combination, only arguments regarding the lack of motivation are provided for review in this request.

To show obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criterion, Appellant respectfully asserts that the rejection does not satisfy at least the first criterion, as discussed further below.

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. There must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. *See* M.P.E.P. § 2143. As explained below, no such motivation exists.

I. *Weis* teaches against such a modification

Claim 1 recites, in part, “said optical signal modulator is an electroabsorption modulator.” Claim 15 recites, in part, “concurrently modulating said electrical signal by interacting with said input light beam using electroabsorption modulation.” Further, claim 22 recites, in part, “an optical intensity modulator.” In an effort to show that the elements of the claims are taught or suggested, the Examiner proposes to modify the system of *Weis* to include an optical intensity modulator, such as an electroabsorption modulator (EAM). However, there is no proper motivation to modify *Weis* by employing an EAM or other optical intensity modulator, as asserted by the Final Action, because *Weis* directly teaches against such a modification. “It is improper to combine references where the references each

away from their combination.” M.P.E.P §2145(X)(D)(2), *citing In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Weis specifically teaches against modifying its disclosed system by using an EAM or other optical intensity modulator. The *Weis* system is a telemetry system for relaying signals from sensors located in “harsh environments,” such as high-radiation areas and in oil/gas well boreholes. *Weis* at Abstract, Col. 6, lines 32-36, and Col. 17, lines 41-50. In its Background section, *Weis* explains that modulating the intensity of a light signal (as by an EAM, one type of intensity modulator) requires “complex” circuitry that is not fit for “harsh borehole” conditions. *Id.* at Col. 2, line 62, through Col. 3, line 29, of *Weis*. Further, *Weis* teaches that systems that use intensity modulators suffer from unreliability because variations in light intensity cause false measurements. *Id.* *Weis* also teaches that using digital data can reduce the occurrence of false measurements; however, *Weis* does not teach the problem of “complex circuitry” is ameliorated by employing such digital data. Accordingly, *Weis* is unequivocal in its teaching that an EAM or other optical intensity modulator cannot be used in its system. In other words, such a modification is specifically taught against by *Weis*, and as a result, one of ordinary skill in the art would not be motivated to make the modification. Such a statement is true regardless of cost, space, and speed—the three criteria listed by the Final Action as possible reasons for making the modification.

II. Such a modification is undesirable

As mentioned above, there are various reasons why employing an EAM or other optical intensity modulator in the system of *Weis* is disadvantageous. For instance, such a modulator may require “complex” circuitry that is not fit for the “harsh borehole” conditions for which the *Weis* system is adapted. *Id.* at Col. 2, line 62, through Col. 3, line 29, of *Weis*. Further, systems that use intensity modulators may suffer from unreliability because variations in light intensity cause false measurements in systems similar to that of the *Weis* system. *Id.* Accordingly, such a modification of *Weis* is undesirable, and as a result, a person of ordinary skill in the art would not be motivated to make the cited modification.

III. Examiner's provided motivation is insufficient

The Final Action attempts to rebut Appellant's argument in the last response by stating:

The Appellant has argued...there is no motivation for using an EAM in *Weis*' system. However, Krause et al in [0050, 0051] teach that in optical systems an EAM can be used or one with similar functionality and this is well known in the art. Barring a showing of criticality in the claimed system the interchangeability of optical modulators is well known by those skilled in the art.

Final Action at 3. However, such reasoning is incorrect for at least two reasons. First, *Krause* (US 2005/0062978) merely teaches a system that employs an EAM, but it does not explain why one of skill in the art would be motivated to modify the *Weis* system with an EAM. Nor does it teach that modulators are interchangeable. Accordingly, *Krause* lends no support to the proposed modification.

Second, by stating that "interchangeability of optical modulators is well known by those skilled in the art," the Final Action attempts to ignore the teaching of *Weis* and replace it with the Examiner's personal knowledge or Official Notice. Such interchangeability of modulators is not true, nor is it well known in the art, as evidenced by the contradictory teaching of *Weis*. Therefore, it is believed that that assertion is not capable of instant and unquestionable demonstration as being well-known, as required of Official Notice by M.P.E.P. §2144.03(A).

Alternatively, such an assertion without documentary evidence may be appropriate if the Office Action provides "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." M.P.E.P. §2144.03(B). However, because the above-quoted statement is merely an assertion, and does not provide reasoning by making technical arguments against the teaching of *Weis*, the Official Notice must fail. Further, *Krause* does not support the assertion, as explained above. Appellant has respectfully requested that the Examiner provide an affidavit or publication supporting such Notice or knowledge under M.P.E.P. § 2144.03(C); however, such an affidavit or publication has not been provided.

For at least these reasons, such an assertion of interchangeability cannot be supported. Moreover, the Office Action mentions cost, space, and speed as criteria for choosing a modulator. Such criteria, however, do not overcome the express contradictory teaching of *Weis* nor the fact that such modification of *Weis* is undesirable. Thus, one of ordinary skill in the art would not be motivated to make the proposed modification. Therefore, the 35 U.S.C. §103(a) rejection of claims 1-3, 5-15, and 17-23 is incorrect and should be withdrawn.

IV. Summary

The proposed modification of *Weis* is directly taught against by *Weis* and is undesirable, as evidenced by *Weis*. Further, the motivation provided by the Examiner is insufficient because it based on unsupported allegations that are directly contradicted by the art of record.

In view of the above, Appellant believes the pending application is in condition for allowance.

Appellant believes no fee is due with this response separate from the fee for the Notice of Appeal. However, if a fee is due, please charge our Deposit Account No. 50-1078, under Order No. 10040010-1 from which the undersigned is authorized to draw.

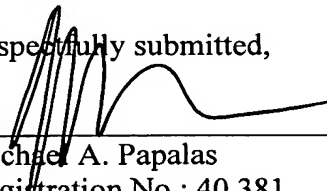
Dated: February 28, 2006

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Dated: February 28, 2006

Signature: Donna Forbit
Donna Forbit

Respectfully submitted,

By 
Michael A. Papalas
Registration No.: 40,381
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